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EXAMINER	
FABER, DAVID	
ART UNIT	PAPER NUMBER
2178	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/26/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/826,935	LLOYD-JONES ET AL.	
	Examiner	Art Unit	
	David Faber	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 February 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6,8,11-15,17-21,23-29,31,34-38 and 40-55* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6, 8, 11-15, 17-21, 23-29, 31, 34-38, and 40-55* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This office action is in response to the amendment filed on 9 February 2007.

2. Claims 1, 15, 17-20, 23, 24, 38, 40-43, 49, 54, and 55 have been amended.

3. Claims 16 and 39 have been cancelled by the Applicant.

4. Claim 56 has been added.

5. Claims 1-6, 8, 11-15, 17-21, 23-29, 31, 34-38, and 40-55 are pending. Claims 1, 23, 24, 55, and 56 are independent claims.

Information Disclosure Statement

6. The information disclosure statement filed 13 March 2006 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the Form PTO-1449 fails to list the EPO Search Report provided with the IDS. Since the EPO Search Report provided is not listed, it fails to comply with 37 CFR 1.98(a)(1), which requires the following: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Claim Rejections - 35 USC § 112

7. The following is a quotation of the sixth paragraph of 35 U.S.C. 112:

> An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

8. As per independent Claim 24, Claim 24 is rejected since the claim recites the limitation "providing means... and storage means..." Examiner is unsure if the means for is referring to any hardware since apparatus is still referring to software, pro se.

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claims 24-29, 31, 34-38, 40-44, and 50-54 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

For your reference, below is a section from MPEP 2105 :

> (a) Functional Descriptive Material: "Data Structures" Representing Descriptive Material Per Se or Computer Programs Representing Computer Listings Per Se
> Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.
> Similarly, computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships

> between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. Accordingly, it is important to distinguish claims that define descriptive material per se from claims that define statutory inventions.
> Computer programs are often recited as part of a claim. Office personnel should determine whether the computer program is being claimed as part of an otherwise statutory manufacture or machine. In such a case, the claim remains statutory irrespective of the fact that a computer program is included in the claim. The same result occurs when a computer program is used in a computerized process where the computer executes the instructions set forth in the computer program. Only when the claimed invention taken as a whole is directed to a mere program listing, i.e., to only its description or expression, is it descriptive material per se and hence nonstatutory.
> **Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and Office personnel should treat a claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, as nonstatutory functional descriptive material. When a computer program is claimed in a process where the computer is executing the computer program's instructions, Office personnel should treat the claim as a process claim. See paragraph IV.B.2(b), below. When a computer program is recited in conjunction with a physical structure, such as a computer memory, Office personnel should treat the claim as a product claim.**

11. Claims 24-29, 31, 34-38, 40-44, and 50-54 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims appear to be claiming "software systems" i.e. systems without hardware indication, which is a computer program per se. Since the claims disclose computer program per se that is not embodied on a computer readable medium, they appear non-statutory.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13. Claims 1-2, 15, 17-18, 20-21, 23-25, 38, 40-44, 49, and 54 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Eintracht et al (US Patent #6,687,878, filed 3/15/1999) in further in view of Berquist et al (US Patent #5,821,931, patented 10/13/1998)

As per independent Claim 1, Eintracht et al discloses a method comprising:

- Providing a list of predetermined metadata labels and associating one or more of the predetermined metadata labels from the list of predetermined metadata labels with each of the plurality of predetermined icons (Column 7, lines 4-17 discloses the image displaying a plurality of notes as labels. The notes are listed in a Note List, which displays a list of all the annotations associated with the image shown in the window. Thus, when a note is selected on the Note List, its counterpart icon in the document window frame is highlighted)
- Displaying the plurality of icons, each of the icons being labelled with one or more of the metadata labels with which the icon was associated. (Fig 1B, 1C, indicator 16: Discloses a plurality of notes in a location that was predetermined placed being attached to various regions on the image (Column 7, lines 1-5) Column 15, lines 11-13, e.g., discloses text can be inputted which produces the note as a label, thus displayed as a metadata label. In addition, the note itself is the icon, while the text input is the labeling

aspect of the icon. Thus, Eintracht et al's note is an icon with metadata label capabilities of being displayed)

- Detecting selection of at least one of the displayed plurality of icons. (Column 15, lines 24-27: Discloses selecting a note to be dragged and dropped to another location on an image. The detection is inherently detected by positioning the cursor over the note and activating the cursor to note enabling it to be moved or dragged to a new location.)
- Determining a location of a subject rendered based on a selection of the subject. (Column 15, lines 24-27: discloses the note being moved to a new different location. When the user moves the note to a new location to be placed, the user is inherently determining a location for the note to be placed.)
- linking the one or more metadata labels associated with the selected icon with a description of the location of the selected subject within the image, and storing the linked one or more metadata labels and the description as an annotation of the image. (Eintracht et al discloses in Column 19, lines 42-67, notes are stored being associated with a document or image and in FIG 11; Column 17, lines 29-30, Eintracht et al discloses an anchor field for each note in a database that stores the coordinates of the of the note in the document thus linking the note to the document and disclosing the precise location of the note in the document.)

Eintracht et al fails to specifically disclose when determining a location on a image of one or more metadata labels associated with the selected icon being related to

said selected subject. However, Eintracht et al discloses that text can be entered into the metadata area (Column 15, lines 11-13). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention that text inputted into a note that it would contain related subject matter to the image the note would be placed on, then place the note with the information onto the subject in the image would have provided the benefit of a user using the note annotation to know the details regarding the subject matter within an image or document.

In addition, Eintracht et al fails to specifically disclose displaying the image adjacent to said plurality of icons. However, Berquist et al discloses in FIG 4, a number of notes being displaying adjacent to an application program executing window containing a document. In addition, FIG 6 discloses a note placed adjacent to a window containing a document before being dragged onto the document. While Berquist et al discloses an embodiment of notes being adjacent to document, Berquist et al discloses a note may be attached to a graphic or a video frame. It was well-known in the art at the time of Applicant's invention document have the ability to contain images, or the application program running had the ability to only show an image, thus therefore it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention that a note could be displayed adjacent to the image within a document or within an application program since Berquist et al would have provided the benefit to Eintracht et al in which preventing objects on the screen from overlapping, and being able to determine a location prior in moving the object onto the desired location.

Furthermore, Eintracht and Berquist fail to specifically disclose the image is displayed after each of the metadata labels has been associated with at least one of the plurality of icons. However, Berquist discloses notes remain on the desktop even though the active window and the inactive window are edited, are closed, or are replaced by other windows. (Column 9, lines 40-43) It was well-known to one of ordinary skill in the art at the time of Applicant's invention that a user can replace an existing window with a new window that had the ability to show an image while the notes containing metadata are still displayed using Berquist's disclosure. Therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention that an window containing an image within a document or program be displayed after one or more notes have been displayed containing metadata since it would have provided the benefit to Eintracht and Berquist saving processing time, improving performance, and saving memory by not having to reload all the displayed notes after application windows are closed and opened throughout a period of time.

As per dependent Claim 2, Claim 2 recites similar limitations as in Claim 1 and is rejected under similar rationale. Eintracht et al discloses a method:

- wherein the selection of said subject is detected by dragging the selected icon to the image and dropping the dragged icon on the subject of the image. (Column 15, line 24-27: Discloses selecting a note to be dragged and dropped to another location on the image. The detection is inherently detected by positioning the cursor over the note and activating the cursor to

note enabling it move dragged to a new location. When the user moves the note to either part of the image and placed, the note is anchored to that coordinate (Column 7, lines 62-64) therefore the subject selected is detected.)

As per dependent Claim 15, Claim 15 recites similar limitations as in Claim 1 and is rejected under similar rationale. Furthermore, Eintracht et al discloses:

- wherein one or more metadata labels are stored as the annotation of the subject and are displayed upon selecting the subject in the image. (Column 7, lines 13-17, discloses when a note is selected on the note list, its counterpart icon in the document window frame is highlighted)

As per dependent Claim 17, Eintracht et al discloses a method:

- The list of metadata labels is provided from a database (Column 7, lines 44-46: coupled to a database; Column 10, lines 40-63)

As per dependent Claim 18, Eintracht et al discloses a method:

- wherein said storing step included storing the one or more metadata labels as the annotation of the subject of the image by using a tag indicating an association with the image (Column 3 Lines 13-36 i.e. the document file for storing one or more documents, a notes database located on the server, the notes database for storing one or more notes, each note or tag associated with a particular document or subject, one or more notes clients coupled to a

network, each notes client operative to locally display a representation of a document remotely stored on the server in the document file, the notes client adapted to permit a user to annotate the document with one or more notes, the notes client operative to simultaneously display the one or more notes associated with the document over the displayed document such that the document is viewable along with the one or more notes

As per dependent Claim 20, Eintracht et al discloses a method further comprising:

- the step of e-mailing at least the image to at least one e-mail address based on the one or more metadata labels associated with the image. (Column 22 Lines 33-37 i.e. emails to client or user)

As per dependent Claim 21, Eintracht et al discloses a method further comprising:

- the step of replacing a default icon by the selected icon based on the subject of the image. (Column 15, lines 10-37,discloses the ability to view, create, modify, or delete notes. Therefore, one can delete the icon located on the selected subject, and either create a new note or move a note to a new location onto that subject).

As per independent Claim 23, Claim 23 recites a "computer readable medium..." for performing the method of Claim 1, and therefore is similarly reject under Eintracht et al and Berquist et al.

As per independent Claim 24, Claim 24 recites an apparatus for performing the method of Claim 1, and therefore is similarly reject under Eintracht et al and Berquist et al. Furthermore, Eintracht et al disclose a display, selection and storage means (Column 28, lines 1-27)

As per dependent Claim 25, Claim 25 recites similar limitations as in Claim 2 and is similar rejected under Eintracht et al and Berquist et al.

As per dependent Claim 38, Claim 38 recites similar limitations as in Claim 15 and is similar rejected under Eintracht et al and Berquist et al.

As per dependent Claim 39, Claim 39 recites similar limitations as in Claim 16 and is similar rejected under Eintracht et al and Berquist et al.

As per dependent Claim 40, Claim 40 recites similar limitations as in Claim 17 and is similar rejected under Eintracht et al and Berquist et al.

As per dependent Claim 41, Claim 41 recites similar limitations as in Claim 18 and is similar rejected under Eintracht et al and Berquist et al.

As per dependent Claim 43, Claim 43 recites similar limitations as in Claim 20 and is similar rejected under Eintracht et al and Berquist et al.

As per dependent Claim 44, Claim 44 recites similar limitations as in Claim 21 and is similar rejected under Eintracht et al and Berquist et al.

As per dependent Claim 49, Eintracht et al discloses a method:

- the linked one or more metadata labels and the descriptions are stored as an annotation of the subject of the image. (Eintracht et al discloses in Column

19, lines 42-67, notes are stored being associated with a document or image and in FIG 11; Column 17, lines 29-30, Eintracht et al discloses an anchor field for each note in a database that stores the coordinates of the of the note in the document thus linking the note to the document and disclosing the precise location of the note in the document.)

As per dependent Claim 54, Claim 54 recites similar limitations as in Claim 49 and is similar rejected under Eintracht et al and Berquist et al.

As per independent claim 56, Claim 56 recites similar limitations as in Claim 1 and is similar rejected under rationale. Furthermore, Eintracht et al discloses displaying a representation of each of the metadata labels in the list. (Column 4, lines 4-17 discloses the image displaying a plurality of notes as labels. The notes are listed in a Note List, which displays a list of all the annotations associated with the image shown in the window. Thus, when a note is selected on the Note List, its counterpart icon in the document window frame is highlighted; Fig 1B, 1C, indicator 16: Discloses a plurality of notes in a location that was predetermined placed being attached to various regions on the image (Column 7, lines 1-5) Column 15, lines 11-13, e.g., discloses text can be inputted which produces the note as a label, thus displayed as a metadata label. In addition, the note itself is the icon, while the text input is the labeling aspect of the icon. Thus, Eintracht et al's note is an icon with metadata label capabilities of being displayed)

14. Claims 3-6, 8, 11, 13, 26-29, 31, 34, 36, 45-48, 50-53, and 55 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Eintracht et al (US Patent #6,687,878) in further in view of Berquist et al (US Patent #5,821,931) in further view of Murray et al (US Patent #6,597,800, filed 9/22/1999).

As per dependent Claims 3 and 4, Eintracht et al and Berquist et al fail to specifically disclose the bounded region is formed based on an analysis of pixels of the image and the analysis of the colour information of the pixels of the image. However, Murray et al discloses a process in which an image is captured by a camera utilizing a two dimensional array of light intensity sensitive pixels that carries out the processing on the image data to separate and identify objects from the background appearing in the image. (Column 1, lines 15-30) Then, Murray et al discloses the bounding box encloses segmented pixels forming homogeneous region of objects of interest. (Column 2, lines 63-65; Column 4, lines 27-30) Therefore, when objects are being identified, being bounded with boxes and separated based on the interest, pixels are being analyzed to determined which pixels are the same within the region to be separate from the different region of pixels based on the color of the pixel or the difference of visible light shown.

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have combined Eintracht et al and Berquist et al's method with Murray et al's method since Murray et al's method since Murray et al's method would have provided the benefit of an automatic recognition of a target object that improves the accuracy of target object recognition and identification.

As per dependent Claims 5, 13, 48, and 53, Eintracht et al and Berquist et al fail to specifically disclose the bounded region is of a predetermined size or determined automatically, and the size of the bounded region is determined based on the analysis. However, Murray et al discloses the bounding box just encloses the segmented pixels forming a primary homogenous region. (Column 2, lines 63-65; Column 4, lines 27-30) Therefore, only bounding related pixels, the box is determined automatically and is predetermined based on the number of related pixels. In addition, when objects are being identified, being bounded with boxes and separated based on the interest, pixels are being analyzed to determined which pixels are the same within the region to be separate from the different region of pixels. Thus, the size is being determined to form a homogenous region.

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have combined Eintracht et al and Berquist et al's method with Murray et al's method since it provided the benefit of only bounding a region of related pixels of interest from regions of no interest.

As per dependent Claim 6, Eintracht et al and Berquist et al fail to specifically disclose the step of forming a bounded region within the image about the location at which the subject is rendered in said image, the bounded region being configured substantially surround the subject. However, Murray et al discloses a bounding box is the rectangle which encloses the segmented pixels forming a primary homogenous region which depicts objects of interest (Column 2, lines 63-65; Column 4, lines 27-30)

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have combined Eintracht et al and Berquist et al's method with Murray et al's method since Murray et al's method since Murray et al's method would have provided the benefit of an automatic recognition of subjects to identify the presence of people.

As per dependent Claim 8, Eintracht et al discloses dragging an icon. Column 15, line 24-27) However, Eintracht et al and Berquist et al fails to specifically disclose a bounded region under the dragged icon is emphasized. On the other hand, Murray et al discloses a bounding box is a rectangle enclosing a region, thus therefore the bounded region being emphasized.

It would have been oblivious to one of ordinary skill in the art the time of Applicant's invention to have combined have combined Eintracht et al and Berquist et al's method with Murray et al's method of bounding box since it provide the benefit of a clear identification of an object that's being identified in an image. (Column 2, lines 63-65; Column 4, lines 27-30)

As per dependent Claim 11, Eintracht et al and Berquist et al fail to specifically disclose the step of extracting a part of the image based on the bounded region. However, Murray et al discloses an image being divided into one or more primary homogenous regions and extracting the data from the image regarding the primary regions. (Column 2, lines 63-67)

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have combined Eintracht et al and Berquist et al's method with Murray et al's method since it provided the benefit of extracting individual complete objects for further image processing.

As per dependent Claim 26, Claim 26 recites similar limitations as in Claim 3 and is similar rejected under Eintracht et al, Berquist et al, and Murray et al.

As per dependent Claim 27, Claim 27 recites similar limitations as in Claim 4 and is similar rejected under Eintracht et al, Berquist et al, and Murray et al.

As per dependent Claim 28, Claim 28 recites similar limitations as in Claim 5 and is similar rejected under Eintracht et al, Berquist et al, and Murray et al.

As per dependent Claim 29, Claim 29 recites similar limitations as in Claim 6 and is similar rejected under Eintracht et al, Berquist et al, and Murray et al.

As per dependent Claim 31, Claim 31 recites similar limitations as in Claim 8 and is similar rejected under Eintracht et al, Berquist et al, and Murray et al.

As per dependent Claim 34, Claim 34 recites similar limitations as in Claim 11 and is similar rejected under Eintracht et al, Berquist et al, and Murray et al.

As per dependent Claim 36, Claim 36 recites similar limitations as in Claim 13 and is similar rejected under Eintracht et al, Berquist et al, and Murray et al.

As per dependent Claims 45 and 46, Eintracht et al fail to specifically disclose the description includes a location and the size of the bounded region within the image. However, Murray et al discloses a bounding box encloses segmented pixels forming a primary homogenous region wherein the information is transmitted to an extraction

device. Since a bounding box is formed around the pixels, the size is by the pixels within the box and a location is found by where the box is located. Thus, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have combined Eintracht et al and Berquist et al's method with Murray et al's method of a bounding box since the bounding box data would have provided the user information on the location of a object of interest and the size of the object within an image.

As per dependent Claim 47, Eintracht et al discloses dragging an icon. Column 15, line 24-27) However, Eintracht et al and Berquist et al fails to specifically disclose a bounded region is formed at a location at which the selected icon is dropped on the image. On the other hand, Murray et al discloses a bounding box is a rectangle enclosing a region of related pixels of an object of interest. (Column 2, lines 63-65; Column 4, lines 27-30)

It would have been oblivious to one of ordinary skill in the art the time of Applicant's invention to have combined have combined Eintracht et al and Berquist et al's method with Murray et al's method of bounding box since it provide the benefit of a clear identification of an object that's being identified in an image.

As per dependent Claims 50-51, Claim 50-51 recites similar limitations as in Claim 45-46 and is similar rejected under Eintracht et al, Berquist et al, and Murray et al.

As per dependent Claims 52, Claim 52 recites similar limitations as in Claim 47 and is similar rejected under Eintracht et al, Berquist et al, and Murray et al.

As per independent Claim 55, Claim 55 recites similar limitations as in Claim 1 and 6 combined and therefore is similar rejected under Eintracht et al, Berquist et al, and Murray et al.

15. Claims 12 and 35 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Eintracht et al (US Patent #6,687,878, filed 3/15/1999) in further in view of Berquist et al (US Patent #5,821,931, patented 10/13/1998) in further view of Murray et al (US Patent #6,597,800, filed 9/22/1999) in further view of Takaha (US Patent #6,021,221, patented 2/1/2000).

As per dependent Claim 12, Eintracht et al, Berquist et al, and Murray et al fail to specifically disclose displaying the extracted part of the image. However, Takaha discloses displaying the extracted image of the pixels that were extracted from the original image (Column 6, lines 2-5; Column 15, line 66 – Column 16, 2)

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have combined Eintracht et al, Berquist et al, and Murray et al's methods with Takaha's method since Takaha's method would have provided the benefit of only showing areas of interest within an image after extracting.

As per dependent Claim 35, Claim 35 recites similar limitations as in Claim 12 and is similar rejected under Eintracht et al, Berquist et al, Murray et al, and Takaha.

16. Claims 14 and 37 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Eintracht et al (US Patent #6,687,878, filed 3/15/1999) in further in view of Berquist

et al (US Patent #5,821,931, patented 10/13/1998) in further view of Murray et al (US Patent #6,597,800, filed 9/22/1999) in further view of Doyle (US Patent #6,616,701, filed 4/3/2001; continuation of appl #09/316,496, filed 5/21/1999; provisional appl. #60/086,620, filed 5/23/1998).

As per dependent Claim 14, Eintracht et al, Berquist et al, and Murray et al fail to specifically disclose that the size of the bounded region is changeable by the user. However, Doyle discloses objects in the image data are interactively outlined in which the user is present. (Column 3, lines 23-25) Since the process of outlining can be done interactively, the user is defining and/or changing the size of the bounded region.

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have combined Eintracht et al, Berquist et al, and Murray et al's methods with Doyle's method since Doyle's method would have provided the method allowing objects within in a single multidimensional dataset to be mapped.

As per dependent Claim 37, Claim 37 recites similar limitations as in Claim 14 and is similar rejected under Eintracht et al, Berquist et al, Murray et al, and Doyle.

17. Claims 19 and 42 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Eintracht et al (US Patent #6,687,878, filed 3/15/1999) in further in view of Berquist et al (US Patent #5,821,931, patented 10/13/1998) in further view of Balabanovic et al (US Patent #6,976,229, filed 12/16/1999).

As per dependent Claim 19, Eintracht et al and Berquist et al fail to specifically disclose the one or more predetermined metadata labels associated with the subject of

the image are stored in an XML file. However, Balabanovic et al discloses metadata regarding information to an image being stored in an XML format/file. (FIG 5(a,b)-6; Column 10, lines 1-3, 21- 22, 40-41)

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have combined Eintracht et al and Berquist et al's method with Balabanovic et al's method of using metadata in XML format since it would have provided the benefit of flexibility to for the file to be easily translated into other formats to viewed by other on different devices.

As per dependent Claim 42, Claim 42 recites similar limitations as in Claim 13 and is similar rejected under Eintracht et al, Berquist et al, and Balabanovic et al.

Response to Arguments

18. Applicant's arguments filed 9 February 2007 have been fully considered but they are not persuasive.

19. On pages 15-18 in regards to claim 1, 23. 24, and 55, Applicant argues that Eintracht and Berquist, individually or in the case they are combined, fail to disclose the features (i) providing a list of metadata labels, (ii) associating each of the metadata labels in the list with at least one of a plurality of icons, and (iii) displaying an image adjacent to a display of the plurality of labelled icons, wherein the image is displayed after each of the metadata labels has been associated with at least one of the plurality of icons. However, the Examiner disagrees,

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Furthermore, Eintracht and Berquist combined teaches the following limitation of the claims. Eintracht teaches the following limitations: Providing a list of predetermined metadata labels and associating one or more of the predetermined metadata labels from the list of predetermined metadata labels with each of the plurality of predetermined icons (Column 7, lines 4-17 discloses displaying a plurality of notes as labels. The notes are listed in a Note List, which displays a list of all the annotations associated with the image shown in the window. Thus, when a note is selected on the Note List, its counterpart icon in the document window frame is highlighted)

However, Eintracht et al fails to specifically disclose displaying the image adjacent to said plurality of icons. However, Berquist et al discloses in FIG 4, a number of notes being displaying adjacent to an application program executing window containing a document. In addition, FIG 6 discloses a note placed adjacent to a window containing a document before being dragged onto the document. While Berquist et al discloses an embodiment of notes being adjacent to document, Berquist et al discloses a note may be attached to a graphic or a video frame. It was well-known in the art at the time of Applicant's invention document have the ability to contain images, or the application program running had the ability to only show an image, thus therefore it

would have been obvious to one of ordinary skill in the art at the time of Applicant's invention that a note could be displayed adjacent to the image within a document or within an application program since Berquist et al would have provided the benefit to Eintracht et al in which preventing objects on the screen from overlapping, and being able to determine a location prior in moving the object onto the desired location.

Furthermore, Eintracht and Berquist fail to specifically disclose the image is displayed after each of the metadata labels has been associated with at least one of the plurality of icons. However, Berquist discloses notes remain on the desktop even though the active window and the inactive window are edited, are closed, or are replaced by other windows. (Column 9, lines 40-43) It was well-known to one of ordinary skill in the art at the time of Applicant's invention that a user can replace an existing window with a new window that had the ability to show an image while the notes containing metadata are still displayed using Berquist's disclosure. Therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention that an window containing an image within a document or program be displayed after one or more notes have been displayed containing metadata since it would have provided the benefit to Eintracht and Berquist saving processing time, improving performance, and saving memory by not having to reload all the displayed notes after application windows are closed and opened throughout a period of time. Thus, Eintracht and Berquist combined teaches the limitations of the claims.

20. On pages 19-20, Applicant argues that the IDS submitted on 10 March 2006 is in compliance with 37 CFR 1.98(a)(1) stating the EPO Search Report is a source of the references and does not necessarily have to be listed. However, the Examiner disagrees.

According to 37 CFR 1.98(a)(1), 37 CFR 1.98(a)(1) clearly states A list of all patents, publications, applications, or other information submitted for consideration by the Office. The EPO Search Report is considered a publication since it released to the public by the EPO for the corresponding European application. Therefore, then the EPO Search Report is considered a publication, it requires to be listed in the IDS to comply with 37 CFR 1.98(a)(1).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Faber whose telephone number is 571-272-2751. The examiner can normally be reached on M-F from 8am to 430pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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